

Appl. No. 09/100,624
Atty. Docket No. 7187
Amdt. dated March 10, 2005
Reply to Office Action of December 29, 2004
Customer No. 27752

REMARKS

Claim 5 has been cancelled without prejudice. Claim 1 has been amended to require the batting to extend through the reinforcing structure of the first lamina. Support for the current amendment to Claim 1 is found in originally submitted Claim 5. No new matter is presented in amended Claim 1. Claims 9 and 16 have been amended to require that the batting of the second lamina extend into the first lamina. Support for the current amendment to Claims 9 and 16 is found in the Specification on page 7, line 2-4 and Figs. 1 and 2. No new matter is presented in currently amended Claims 9 and 16. Claims 1-3, 6-9, 11-18, and 20-25 remain pending in the instant Application and are presented for the Examiner's review in light of the above amendments and the following comments.

35 U.S.C. §103 Rejection

In the action dated December 29, 2004, the Examiner indicated that Claims 1-3, 5-9, 11-18, and 20-25 stand rejected under 35 U.S.C. §103(a) over Trokhan et al., U.S. Patent No. 5,556,509, in view of Trokhan et al., U.S. Patent No. 5,624,790. It should be noted that the Examiner has maintained the rejection of Claims 9, 11-18, and 20-21 for the reasons of record. According to Applicants' files, the Office Action dated April 5, 2001 rejected Claims 9, 11-18, and 20-21 under 35 U.S.C. §103(a) over Trokhan et al., U.S. Patent No. 5,556,509, in view of Trokhan et al., U.S. Patent No. 5,624,790. For the sake of brevity, since these rejections overlap, Applicants shall address the rejection of Claims 1-3, 5-9, 11-18, and 20-25 under 35 U.S.C. §103(a) over the references of record. Therefore, Applicants traverse this rejection for the following reasons:

1. Applicants' invention as now presented in Claim 1 by amendment claims a papermaking belt comprising, *inter alia*, a first lamina having a reinforcing structure and a second lamina comprising batting. The batting of the second lamina extends through the reinforcing structure of the first lamina.
2. Similarly, Claims 9 and 16 claim a papermaking belt comprising, *inter alia*, a first lamina and a second lamina comprising batting. The batting of the second lamina forms a second surface of the laminate and extends into the first lamina. Such extension of the claimed batting is depicted in Figs. 1 and 2 of the instant Specification.
3. As disclosed by Applicants, the placement of batting between the first lamina and the second lamina enhances the hydraulic connection therebetween. (7:4-7)

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4. Applicants concur with the Examiner that while the '509 reference discloses a papermaking belt comprising a woven fabric having a felt layer on either side of the woven layer and a discontinuous photosensitive resinous coating on the paper-facing side of the belt, the '509 reference fails to teach a woven reinforcing layer supporting a photosensitive resinous material layer.
5. However, neither the '509 reference nor the '790 reference discloses or provides any motivation for the extension of batting from the second lamina into the structure of the first lamina. Such extension provides for an enhanced hydraulic connection between the first and second lamina and thus, the first and second sides of the laminate.
6. It is well settled Federal Circuit case law that, "A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 65 U.S.P.Q.2d 1961 (Fed. Cir. 2003) (*citing* *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "[Absence] of such a suggestion to combine is dispositive in an obviousness determination." *See Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000) (*citing* *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997)). It should also be noted that, "[It] is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 U.S.P.Q.2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990). "The mere fact that the prior art could be so modified [does not make] the modification obvious unless the prior art suggested the desirability of the modification." *See In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989).

Absent any motivation to provide a papermaking belt having a first lamina comprising a reinforcing structure and a second lamina comprising batting whereby the batting of the second lamina extends through the reinforcing structure of the first lamina or extends into the first lamina, the combination of the '509 and '709 Trokhan references cannot render any of the rejected claims obvious. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); M.P.E.P. §2143.01. Applicants, therefore, request reconsideration and withdrawal of Examiner's 35 U.S.C. §103(a) rejection to Applicants' instant Claims 1, 9, and 16 and the claims dependent thereon.

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Summary

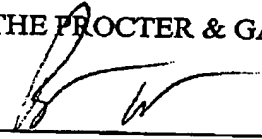
Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims are in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, thus no fees are believed due. However, if any additional charges are due, the Examiner is authorized to deduct such charge from our Deposit Account No. 16-2480 herewith.

Respectfully submitted,

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